

Application No: 10/665,509 Docket No.: Q137-US9

Page 6

REMARKS

Claims 58-59, and 68-87 were previously presented. Claims 1-57 and 60-65 were previously canceled. Claims 66 and 67 are currently amended. Accordingly, claims 58-59, and 66-87 are pending examination.

Elections/Restrictions

The Applicant does not make an election in this Amendment and has not made any elections in prior Amendments.

Rejection of Claim 58 Under 35 USC §102(e)

Claim 58 are rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 5,501,916 (Teramoto).

To support this rejection, the Office Action relies on Teramoto's Figure 9 as described in example 2. Claim 58 recites that "an electrode is electrically insulated from the pin but is in electrical communication with a second end cap" (emphasis added). Accordingly, in order to properly support the anticipation rejection, Teramoto must teach an electrode that is insulated from a pin but is in electrical communication with an end cap. However, Teramoto teaches that the positive electrode is in electrical communication with the core and the negative electrode is in electrical communication with the can (C8, L47-53). Accordingly, the negative electrode may be insulated from the core and in electrical communication with the can, however, Teramamoto also teaches that each of the battery lids is caulked to the battery can by an insulating gasket (C8, L58-60 and 64-67). Since the negative electrode is in electrical communication with the can but the can is insulated from each of the lids (see also Figure 9 and note that the core is in electrical communication with each of the battery lids), the negative electrode is electrically insulated from each of the battery lids. As a result, Figure 9 and the cited text does not teach "an electrode (that) is electrically insulated from the pin but is in electrical communication with a second end cap," the Office Action does not support a rejection of the pending claims for anticipation in view of Teramoto.

Application No: 10/665,509 Docket No.: Q137-US9

Page 7

Rejection of claims 59 and 66-87 under 35 USC §102(e) or 35 USC §103

Each of claims 59 and 66-87 depends directly or indirectly from independent claim 58. Since claim 58 is believed to be in condition for allowance, claims 59 and 66-87 are also believed to be in condition for allowance.

Rejection of Claims 58, 59, 66-87 Under 35 USC §112

Claims 58, 59, and 66-87 are rejected under 35 USC §112, first paragraph, as based on a disclosure which is not enabling. In particular, the Office Action argues that the “electrically conductive terminal pin being electrically insulated from the case’ is critical or essential to the practice of the invention, but not included in the claim, is not enabled by the disclosure.” Accordingly, this rejection appears to be an argument that insulation of the pin from the case is critical to the operation of the claimed method and accordingly must be included in the claimed method.

In support of this rejection, the Office Action cites *In re Mayhew* which is discussed in MPEP §2164.08(c). MPEP §2164.08(c) addresses enablement when an allegedly critical feature is not claimed and is accordingly central to this rejection. This rejection stems from an improper application of the law in MPEP §2164.08(c).

In order to support an enablement rejection under MPEP §2164.08(c), the specification must teach that that insulation of the pin from the case is critical to the claimed method of constructing the battery. For instance, MPEP §2164.08(c) states that “(a) feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement” (emphasis added). This same section of the MPEP also provides that this rejection “should be made **ONLY** when the language of the specification makes it clear that the limitation is critical for the invention to function as intended” (emphasis added). Accordingly, in order for MPEP §2164.08(c) to be properly applied, the specification must teach that insulation of the pin from the case is critical to the operation of the claimed method of constructing the battery.

The only place that the pending Office Action cites as teaching the pin insulated from the case is in “originally filed claim 58.” However, what was originally filed as claim 58 cannot serve as evidence of what is critical to operation of other claims. If the

Application No: 10/665,509 Docket No.: Q137-US9

Page 8

mere presence of a feature in a claim to a battery construction method indicates that the feature is critical to all battery construction methods, then the logical application of MPEP §2164.08(c) would require that all of the claims to the battery construction method have the same features. Since there is obviously no such requirement, the presence of a particular feature in a claim to a battery construction method DOES NOT indicate that the feature is critical to the other battery construction method claims.

Further, many of the originally filed claims do not recite that the pin is insulated from the case. In fact, many of the claims that do not recite that the pin being insulated from the case are directed to a "method of constructing an electric storage battery" just like "originally filed claim 58" and just like the currently pending claims. For instance, originally filed claims 20-23 and 26-27 are directed to a "method of constructing an electric storage battery" but none of these claims recite that the pin is insulated from the case. In fact, originally filed claim 21 recites "mounting said spiral roll in a case with said pin outer end extending exteriorly of said case to form a first battery terminal" but does not require that the pin is insulated from the case. If it can be argued that the presence of this feature in claim 58 indicates that this feature is critical to something other than originally filed claim 58, then it can also be argued that the absence of this feature from claims 20-23 and 26-27 shows that the feature is not critical to all "method(s) of constructing an electric storage battery." As a result, the presence of this feature in originally filed claim 58 does not indicate that this feature is critical to the currently claimed method.

Because "originally filed claim 58" is the only place that the pending argument cites as teaching the pin insulated from the case and the presence of this limitation in "originally filed claim 58" does not indicate that this limitation is critical to the operation of other claims, "originally filed claim 58" does not properly support the rejection under MPEP §2164.08(c). As a result, the pending argument does not properly support the rejection under MPEP §2164.08(c).

Additionally, the specification actually teaches embodiments of the battery where the pin need not be insulated from the case. The Applicant deemed this teaching to be important enough to be included in the "Summary of the Invention" section of the

Application No: 10/665,509 Docket No.: Q137-US9

Page 9

specification. In particular, the specification teaches that the "battery case itself **generally** functions as the other battery terminal" at page 3, line 19-20 (emphasis added). MPEP §2164.08(c) specifically states that this teaching cannot be ignored and must be taken into consideration when it states that in "determining whether an unclaimed feature is critical, **the entire disclosure must be considered.**" Since the term "generally" indicates a condition that is not always true, properly taking this sentence into consideration shows that the case need not function as the other battery terminal. When the case does not function as the other terminal, the pin can be in electrical communication with the case without shorting the battery. If the pin can be in electrical communication with the case, then there is no reasonable argument that the specification teaches that it is critical for the pin to be insulated from the case.

Since the specification does not teach that it is critical for the pin to be electrically insulated from the case, MPEP §2164.08(c) provides that rejection for lack of enablement is not supported. Accordingly, the claims need not specify that the pin is electrically insulated from the case and the rejection should be withdrawn.

Application No: 10/665,509 Docket No.: Q137-US9

Page 10

CONCLUSION

The Examiner is encouraged to telephone or e-mail the undersigned with any questions.



Travis Dodd
Reg. No. 42,491
Agent for Applicant(s)

Quallion LLC
P.O. Box 923127
Sylmar, CA 91392-3127
818-833-2003 ph
818-833-2065 fax
travisd@quallion.com